

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/572,643

Applicant(s)

MOCHIZUKI ET AL.

Examiner

Brett A. Crouse

Art Unit

1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-4 and 6-13.
 Claim(s) withdrawn from consideration: 5.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.

/Marie R. Yamnitzky/
 Primary Examiner, Art Unit 1794

Continuation of 11. does NOT place the application in condition for allowance because:

The request for reconsideration does not place the case in condition for allowance because the proposed amendment introduces new limitations which have previously not been considered.

With regard to the proposed amendment and declaration the proposed amendment and declaration would potentially raise various issues as outlined below.

1. A potential 112 first paragraph issue with regard to the scope of enablement due to the temperature and time limitation. Attention is directed to instant example 1 versus instant comparative example 1. The reaction conditions are the same, however, in the comparative example a suitable inventive device is not formed. If the proposed temperature and time limitation is established as critical to the invention there is no limit as to the dopant (diffusing) material of the independent claim(s) beyond dyes and charge transport materials. However, based on the disclosure of the instant specification it is unclear as to what dopant materials other than the materials of the examples would form an inventive device at this temperature/time.

2. The scope of the showing of materials of the instant specification and declaration is not commensurate in scope with the scope of the independent claims. As noted above there is no limit as to the diffusing compounds beyond dyes and charge transport materials.

3. The scope of the showing of materials of the instant specification and declaration is not commensurate in scope with the breadth of the materials of the prior art references.

4. With regard to the selection of 120 degrees Celsius it is noted that Yu teaches heating the material(s) to cause diffusion or contacting the material(s) with toluene vapor to cause diffusion. The boiling point to toluene is about 111 degrees Celsius, which is close to the proposed temperature. The MSDS sheet for toluene is included with this mailing to provide the boiling point of toluene. (Section 9)

It is noted that these concerns could potentially be overcome by limiting the scope of the claims to materials for which the proposed reaction conditions could be shown to be critical.

(A) It is noted by the examiner that there is a potential typographical error in instant example 3 of the specification on page 15, line 11. The dopant is recited as PBT. Later in the example page 16, line 9, PBD is recited as the vaporization source.

Continuation of 13. Other: A PTO-892 and attached reference are included with this mailing.